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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,953

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EXAMINER

DICUS, TAMRA

ART UNIT

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1794

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/581,953	<b>Applicant(s)</b> YOKOCHI ET AL.	
	<b>Examiner</b> TAMRA L. DICUS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The RCE is acknowledged.

**The following rejections are withdrawn:**

- The prior 112 rejections.
- Claims 1-8, and 10 rejected under 35 U.S.C. 102(b) as being anticipated by Takeuchi et al.
- Claims 1-8, and 10 stand rejected under 35 U.S.C. 102(b) as being anticipated by Takemoto.
- Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arai et al. as previously set forth in the 6/14/07 Office Action.
- All 103 rejections in view of Rosenkranz.

**The following rejections are applied:**

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 4-7, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Instant Claims 2, 5, and 10 are not clear because the structure is not clear. Careful revision is necessary to put the claims in proper form to convey the scope of the invention as Applicant intends. Particularly, it is not clear if "the paper "referenced in claim 2 and the impregnated paper" in claim 5 further comprises separate impregnated papers as in another layer, or reference both first and second impregnated papers, because the impregnated blocking layer is not comprised of an impregnated paper (i.e. "base material *comprises a* second impregnated

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paper ”). Thus, it’s not clear how many layers are present. It appears the phrases lack antecedent basis while attempting to create a new layer or ingredient, but relying on one paper in one layer which is confusing (because the blocking layer and impregnated paper layers are different). It is not clear if there is an additional second paper layer within the blocking layer. Claim 10 has similar issues with the base material, it is not clear if there is an additional base layer in addition to the one already mentioned in claim 1. Thus the overall structure for Claims 2, 4, and 10 is not clear.

4. Further to Claim 6, this amendment is confusing as it is not clear how – “an independent blocking layer” further limits the blocking layer. The blocking layer is a layer so it is already independent. Further the blocking layer is comprised in the surface resin layer which makes it dependent it appears. The language is ambiguous. Similar issues exist with Claims 4-7.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

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with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8, and 10 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6514624 to Takemoto in view of Takeuchi et al, and over claims 1-10 of US 6558799 to Takeuchi in view of Takemoto.

7. Takemoto teaches the same structure as instant claim 1 except the primer layer between the pattern and surface layer is not recited as a blocking layer, however because it is in the same position, and below the surface resin layer of curing resin, it functions as a blocking layer. See patented claims. The substrate of Takemoto is not claimed, however, Takeuchi teaches impregnated paper substrates (implying two and second paper). It would have been obvious to one having ordinary skill in the art to have modified the claims of Takemoto to envision a blocking layer and impregnated paper substrate because Takeuchi teaches the same order, using similar materials and the paper substrate is conventional for decorative materials (5:1-60, Examples, and all patented claims). Takeuchi essentially teaches all the same elements and order, but teaches curing layers in three layers, one may serve as a blocking layer, and the substrate of impregnating paper is missing. Takemoto teaches an impregnated paper in Example 1 as a suitable substrate. It would have been obvious to one having ordinary skill in the art to have modified the decorative material of Takeuchi because Takemoto teaches impregnated paper in Example 1 as a suitable substrate, thus using more than one is obvious to further support the decorative material.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-8, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Malina et al.

Takemoto teaches per instant claim 1 (currently amended), a decorative material comprising a surface layer (3, 2b, 2a, FIGs. 2-3 and associated text/ patented claim 1) and a base material layer (1, FIGs. 2-3 and associated text/ patented claim 1, first impregnated paper) laminated and integrated on a rear surface thereof, wherein the surface layer comprises at least a surface resin layer (3, FIGs. 2-3 and associated text/ patented claim 1) comprised of a ionizing radiation curable resin, an impregnating blocking layer (sealer 4, patented claim 1, 6:49-68 - impregnating two part urethane resin into substrate 1, thus functioning as impregnated blocking layer) for inherently blocking an ooze out of an uncured material (uncured from the upper layer) of a thermosetting resin, and an impregnated paper layer formed by a paper impregnated with the thermosetting resin and cured (1, FIGs. 2-3 and associated text, impregnated with same resin), laminated from a surface side; at least an uppermost surface of the base material layer comprises the impregnated paper layer (1, FIGs. 2-3 and associated text); and a pattern ink layer (2, FIGs. 2-3 and associated text). Primer layer 5 functions as an independent blocking layer, that is not impregnated as its of a coat of acrylic and urethane resins (7:40-63). Takemoto employs a two-

component urethane resin as the ionizing impregnating resin (6:55-60). Claims 1-8 are addressed. To instant claim 10, see 7:63-8:20, further that it is to be adhered is intended use.

Takemoto doesn't teach a second impregnated paper.

Malina teaches a similar decorative material wherein any number of impregnated papers including and showing at least two below the substrate in FIG. 1 for balancing and depending upon the application the number of sheets are varied. See Abstract, 13:1-60.

It would have been obvious to one having ordinary skill in the art to have modified the bottom impregnated paper by supplying an additional second impregnated paper for balancing and variation dependent upon the end application as taught by Malina cited above.

14. Claims 8-9 and 11-12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto in view of Malina et al. and further in view of Rosenkranz et al.

The combination is applied above teaching the claimed invention.

Takemoto explicitly teach a two component urethane resin as per Claims 8-9 and 11-12.

Rosenkranz teaches a two component urethane acrylate impregnating resin (2: 31-42) comprised of alkylene oxides, such as ethylene oxide (3:1-33) in the B component for impregnating to strengthen textile webs and coloring purposes.

It would have been obvious to one having ordinary skill in the art to have modified the decorative material of the combination to include a urethane acrylate resin comprising ethylene oxide as claimed because Rosenkranz teaches a two component urethane resin assists as an impregnate used in webs for strengthening and coloring purposes (Abstract, 2: 31-42, 3:1-33).

***Response to Arguments***

Applicant's arguments filed 06/05/08 have been fully considered but they are not persuasive.

Applicant's arguments with respect to all applied references have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the Double Patenting, 102, and 103 rejections on the grounds that the amended second impregnated paper is not taught, however, this is obvious for supporting decorative material as recited above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/  
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/  
Examiner  
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July 31, 2008